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No. 02-90

Supreme Court, U.S.
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In The

Supreme Court of the United States

TALBERT FUEL SYSTEMS PATENTS CO.,

Petitioner,

v.

UNOCAL CORPORATION and
TOSCO CORPORATION,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT TOSCO CORPORATION'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether there is a reasonable probability that reconsideration in light of this Court's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. __, 122 S. Ct. 1831 (U.S. 2002) (*Festo*) would alter the Federal Circuit's conclusion that Petitioner's intentional and specific surrender of coverage of the accused products precludes infringement under the doctrine of equivalents.

CORPORATE DISCLOSURE STATEMENT

Respondent Tosco Corp., is a wholly owned subsidiary of Phillips Petroleum Company. No publicly held company owns 10% or more of the stock of Phillips Petroleum Company.

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RESPONDENT TOSCO CORP.'S BRIEF IN OPPOSITION TO THE PETITION

SUMMARY

The Petition for *certiorari* should be denied because this Court's *Festo* decision, as well as prior decisions of this Court, unequivocally preclude infringement under the doctrine of equivalents in this case.

During the prosecution of the asserted patent, Petitioner Talbert attempted to obtain claims that literally would have encompassed gasolines having the range of final boiling points of the accused products. The Patent Office repeatedly rejected these claims as unpatentable in view of several prior art patents. In response, Talbert amended his claims to recite a specific final boiling point temperature of 345°F and argued to the Patent Office that the amended claims no longer covered gasolines having final boiling points above the recited limit. As such, the amended claims no longer covered the accused gasolines.

The Federal Circuit held that prosecution history estoppel precluded infringement under the doctrine of equivalents because Talbert had intentionally and specifically surrendered coverage of gasolines having the final boiling points Talbert was seeking to recapture as an equivalent. Thus, this Court's *Festo* decision would not affect the outcome of the Federal Circuit's decision in this case because it was based on a deliberate surrender by Talbert, a classic basis for prosecution history estoppel expressly reaffirmed by this Court in *Festo*.

Simply because the Federal Circuit cited its now-vacated *Festo* decision in holding that Talbert was

estopped from asserting that the accused gasolines infringe under the doctrine of equivalents does not automatically require this Court to vacate and remand for further consideration. In the decision below, the Federal Circuit applied traditional rules of estoppel by surrender or disclaimer – not any absolute bar – and could have cited any number of prosecution history estoppel cases, including this Court's decision in *Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040 (1997), as support.

In asserting infringement under the doctrine of equivalents, Talbert attempts to recapture final boiling point temperatures that were easily quantifiable, described in the specification, and the very subject of Talbert's express arguments and amendments to the Patent Office. Because the Federal Circuit's decision in this case is not affected by this Court's *Festo* decision, Talbert fails to meet the requirements for a "GVR"[1] and the Petition should be denied.

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[1] A "GVR" may be granted only where there is "a reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration, and where it appears that such a redetermination may determine the outcome of the litigation. . . . " *Lawrence v. Chater*, 516 U.S. 163, 167-68, 116 S. Ct. 604, 607 (1996). "[I]f the delay and further cost entailed in a remand are not justified by the potential benefits of further consideration by the lower court, a GVR order is inappropriate." *Id.* at 168, 116 S. Ct. at 607.

REASONS FOR DENYING THE PETITION

A. This Court's *Festo* Decision Precludes Infringement Under The Doctrine Of Equivalents Because Talbert Intentionally Surrendered Coverage Of The Accused Gasolines

Talbert agrees that the patent claim at issue requires a boiling point range of 121°F-345°F. *See* Pet. Br. at 5; App. 5-6 ("said gasoline having a boiling point range of 121-345°F") (quoting Claim 1); App. 10 (claim construction analysis confirming that Claim 1 is limited to an upper boiling point of 345°F). The Federal Circuit found, and Talbert does not dispute, that the gasolines accused of infringement exhibit final boiling points between 373.8°F and 472.9°F and, therefore, cannot literally infringe the '356 patent. *See* App. 11 ("Talbert conceded that there was not literal infringement."); App. 26 (Talbert's admission before the district court). Talbert's sole contention is that the final boiling points of the accused gasolines, 373.8°F to 472.9°F, are somehow equivalent to the claimed final boiling point of 345°F, and, therefore, these gasolines infringe the claim under the doctrine of equivalents. *See* App. 32; Pet. Br. at 2, 8-9 (asserting the Federal Circuit's application of *Festo* as the basis for the GVR request).

Both the district court and the Federal Circuit held that prosecution history estoppel precluded a finding of equivalence as a matter of law. By adding the 345°F final boiling point to the claim and arguing that this limitation was critical and a basis for patentability over the prior art, Talbert unconditionally surrendered coverage of gasolines having final boiling points as high as the accused gasolines. *See* App. 33 (district court's analysis based on pre-*Festo* law); App. 11-12 (affirming district court).

Talbert initially sought a claim that would have literally encompassed the final boiling points of the accused gasolines. *See* Resp. Ct. App. Br. at 6 (quoting Claim 1 of Talbert's original application having no boiling point limitations). The Patent Office rejected this claim as unpatentable in view of two prior U.S. patents. *Id.*; *see* Ct. App. JA513-15 (Patent Office rejection). Talbert resubmitted this claim in a continuation application and the Patent Office again rejected the claim as unpatentable, in part, in view of U.S. Patent No. 3,002,917 to Hamilton ("Hamilton"). *See* Resp. Ct. App. Br. at 6; *see also* Ct. App. JA590-92 (Patent Office rejection). The Hamilton patent disclosed a gasoline having a final boiling point of 390°F. *See* App. 11.

In response to these repeated rejections, Talbert eventually amended the claim to specifically recite an upper boiling point of 345°F so as not to cover the 390°F final boiling point disclosed in Hamilton. *See* Resp. Ct. App. Br. at 9-10; *see also* Ct. App. JA634-37 (response to rejection). By this amendment, Talbert surrendered claim scope that he may not recapture through the doctrine of equivalents. "[A] patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims." *Wilson Sporting Goods v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990); *see Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1299 (Fed. Cir. 1999) ("After adding a claim limitation during prosecution to overcome prior art, the applicant cannot later assert that the distinguished feature of the prior art is equivalent to the added limitation."). Talbert cannot obtain claim scope through the doctrine of equivalents that the Patent Office refused to give him literally.

In conjunction with the claim amendment, Talbert expressly disclaimed any range of equivalents that would encompass the accused gasolines by asserting that the claimed temperature range was not equivalent to the 390°F final boiling point disclosed in Hamilton:

> the temperature range of the boiling points of the hydrocarbons of the gasoline of the presently claimed invention is between 96.8° and 345°F. **There is absolutely no suggestion of such a gasoline composition in the Hamilton reference [which discloses a boiling point of 390°F].**

App. 9 (emphasis added). Talbert further argued that the Hamilton patent:

> teaches away from [the claimed] fuel by providing for a fraction having a boiling range up to 390°F (column 1, lines 42-43). **This fraction is not the same as, nor equivalent to, that which is the subject of applicant's composition claims.**

Id. (emphasis added). Talbert explained that:

> **'fuel having hydrocarbon components with boiling points above those claimed [345°F]' would function in a manner that 'completely negate[s] an important characteristic of the composition of the invention.'**

Id. (emphasis added). Based on these express and unequivocal representations, the Federal Circuit found that "Talbert emphasized the difference in boiling point ranges as the distinction on which he premised patentability." *Id.*

The Federal Circuit held that by repeatedly asserting during prosecution that the 345°F final boiling point of the

claimed gasolines was **not** equivalent to the 390°F final boiling point disclosed in the prior art, Talbert was estopped from asserting that the accused gasolines, having a final boiling point of 373.8°F to 472.9°F, were equivalent to the claimed final boiling point. *See* App. 11-12. There is no reasonable probability that this result would change were the Federal Circuit to reconsider the issue in light of this Court's *Festo* decision.

In *Festo*, although this Court rejected the Federal Circuit's "absolute bar" for claim amendments, it reaffirmed the longstanding rule that where a patentee deliberately surrenders coverage of a known equivalent, that equivalent cannot be recaptured through the doctrine of equivalents. *See Festo*, 122 S. Ct. at 1838 (*quoting Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-37, 62 S. Ct. 513, 518 (1942)). *Festo* did not change this fundamental aspect of the law of equivalency. *See Exhibit Supply*, 315 U.S. at 136-37, 62 S. Ct. at 518 ("By the amendment [the patentee] recognized and emphasized the difference between the two [claim] phrases and proclaimed his abandonment of all that is embraced in that difference. The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him.").

This Court's rejection of the Federal Circuit's absolute bar rule and substitution of a rebuttable presumption of estoppel are plainly not relevant to the facts of this case. The newly-created presumption applies in instances not present here, such as where the alleged equivalent was unforeseeable, could not adequately be captured by the patentee due to the vagaries of language, or was merely tangentially related to the amendment. *See Festo*, 122

S. Ct. at 1842 ("There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.").

Unlike *Festo*, the instant case involves an express surrender of an admittedly known range of final boiling points and simply does not require an evaluation of whether the patentee can rebut the presumption. The law with respect to clear and unmistakable surrender of known equivalents is the same after *Festo* as it was before. *See, e.g., Exhibit Supply*, 315 U.S. at 136-37, 62 S. Ct. at 518. Accordingly, a remand to the Federal Circuit would be futile because there has been no change in the law as applied to the facts of this case.

Even if evaluation of the presumption were appropriate, however, Talbert cannot possibly prevail. The alleged equivalents were known and foreseeable at the time of the amendment, and Talbert's arguments were intended to overcome the prior art. Talbert undeniably argues that gasolines having final boiling points above 345°F are described in the '356 patent. *See* Pet. Br. at 4 ("The specification notes that . . . the actual final boiling points of even the gasifier gasoline could exceed [345°F]."); Pet. Ct. App. Br. at 13 (same). In view of this argument, Talbert cannot possibly argue that the allegedly equivalent gasolines,

having final boiling points above 345°F, were unforeseeable. An alleged equivalent expressly described in the patent specification is the epitome of being "foreseeable."[2]

Moreover, this case involves specific ranges for gasoline boiling points. Because these boiling points are precisely defined in terms of numerical values, there can be no serious argument that the inadequacies of language somehow prevented Talbert from literally claiming the allegedly equivalent final boiling points as his invention. Indeed, Talbert initially claimed the allegedly equivalent final boiling points only to then have to narrow the claims when the Patent Office rejected the broader claims as being unpatentable over the prior art.

Finally, Talbert specifically added the final boiling point of 345°F to his claims to overcome a prior art patent disclosing a gasoline having a final boiling point of 390°F, which is squarely within the final boiling point range of the accused gasolines. App. 11 ("the prosecution record shows that Talbert relied on this temperature specificity for patentability purposes"). There can be no argument that the amendment was merely "tangential" to the alleged equivalent. As the Federal Circuit found, the

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[2] Talbert's own argument that his patent discloses gasolines having final boiling points above 345°F further supports the conclusion that the doctrine of equivalents is unavailable to Talbert to cover the accused gasolines. *See Miller v. Bridgeport Brass Co.*, 104 U.S. 350, 352 (1881) ("The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed."); *see also Mahn v. Harwood*, 112 U.S. 354, 361 (1884) ("The claim actually made operates in law as a disclaimer of what is not claimed.").

amendment was specifically intended to distinguish the claimed invention from the gasolines disclosed in the prior art, and consequently, the accused gasolines. *Id.* Accordingly, even if evaluation of the presumption were appropriate, such an analysis could not possibly change the result in this case.

Because the amendments and arguments at issue were expressly designed to eliminate gasolines having the allegedly equivalent final boiling points from the scope of the claim, this Court's *Festo* decision precludes infringement under the doctrine of equivalents. A remand to the Federal Circuit to reconsider the issue would be pointless and wasteful. At a minimum, "the delay and further cost entailed in a remand are not justified by the potential benefits of further consideration" and a GVR order is therefore inappropriate. *Lawrence*, 516 U.S. at 168, 116 S. Ct. at 607.

B. Talbert's Petition Fails To Even Allege How Reconsideration Could Change The Outcome In This Case

Talbert correctly recognizes that the standard for the grant of a GVR is whether a redetermination by the lower court in view of recent developments from this Court may determine the ultimate outcome of the case. However, Talbert's Petition fails to show how reconsideration by the Federal Circuit in this case could possibly change the outcome. Talbert merely avers that a GVR is appropriate because the Federal Circuit cited *Festo* in reviewing the district court's judgment of noninfringement. *See* Pet. Br. at 8. From this, Talbert concludes that it should be given an opportunity to show that his claim amendment did not surrender the alleged equivalents. *See id.* at 9-10. But

unlike *Festo*, Talbert's estoppel was not based on a single claim amendment for which the reason was unknown. Rather, as discussed above, Talbert's estoppel was based on his repeated and unequivocal assertions to the Patent Office that the claims did not encompass the gasolines that Talbert now asserts are equivalent. *See, e.g.*, App. 11-12. Talbert has wholly failed to show that there is a reasonable probability that the Federal Circuit's decision would be different upon further consideration.[3] *See Lawrence*, 516 U.S. at 167-68, 116 S. Ct. at 607. Merely noting that the Federal Circuit cited *Festo* in its opinion is insufficient to warrant a GVR in this case. While Talbert obviously would like to ride the recent wave of GVR's precipitated by this Court's *Festo* decision to have yet another chance to reargue infringement, the facts simply do not support Talbert.

CONCLUSION

The Federal Circuit's decision below rejecting Talbert's claim of infringement under the doctrine of equivalents does not implicate this Court's rejection of the absolute bar rule in *Festo*. Talbert's infringement claim is precluded under traditional rules of estoppel by surrender. This Court's *Festo* decision did not change the law with respect to unequivocal surrenders of known equivalents.

[3] Talbert incorrectly asserts that the Federal Circuit failed to acknowledge that if limited to a single final boiling point, the preferred embodiment would be excluded. *See* Pet. Br. at 10. First, this argument is unrelated to this Court's *Festo* decision. Second, the Federal Circuit's opinion specifically rejects this very argument. *See* App. 10.

Because there is no possibility, let alone a reasonable probability, that the Federal Circuit's decision rested upon the absolute bar of its *Festo* decision, a remand for further consideration in view of this Court's *Festo* decision is unwarranted.

Respectfully submitted,

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